

Appln No. 09/754,103
Amdt date October 7, 2005
Reply to Office action of May 9, 2005

REMARKS/ARGUMENTS

Claims 15-32 remain in the present application, of which claims 15, 24 and 30 are independent. Claims 1-14 and 33-88 have previously been cancelled. Claims 15, 17, 24, 26 and 30 have been amended herein, of which claim 15 has been amended for a clerical reason not related to patentability. Applicants thank the Examiner for the indication that claims 24 and 30-32 are allowable. Applicants respectfully request reconsideration and allowance of claims 15-23 and 25-29 in addition to maintaining the allowability of claims 24 and 30-32.

I. Telephone Interview

Applicants thank the Examiner for the time and courtesy extended to applicants' attorney (Jun-Young E. Jeon; Reg. No. 43,693) during the telephone interview of August 10, 2005. During the interview, applicants' attorney requested that the Examiner point out the particular part of a reference relied on for rejection under 35 U.S.C. § 102(b), as required, since such particular part was not indicated in the Office Action. See 37 CFR § 1.104(c)(2). The reference in question is U.S. Patent No. 5,651,047 ("Moorman et al."), which is a complex reference having 125 pages including 87 drawing sheets. The Examiner, however, did not provide any guidance during the telephone interview on the particular part relied on for the § 102(b) rejection.

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II. Rejection of Claims 26-29 under 35 U.S.C. § 112

Claims 26-29 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Office Action states that "[t]here is insufficient antecedent basis for this limitation [the balloon] in the claim [26]." Applicants have amended claim 26 to overcome this rejection. Therefore, applicants request that the rejection of claim 26 under 35 U.S.C. § 112, second paragraph, be withdrawn. Since claims 27-29 depend from claim 26 and their §112 rejection was based on the rejection of claim 26, applicants request that the §112 rejection of claims 27-29 be withdrawn as well.

III. Rejection of Claims 15, 16, 18, 20-23 and 25-29¹ under 35 U.S.C. § 102(b)

Claims 15, 16, 18, 20-23 and 25-29 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Moorman et al.

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal*

¹ While the Office Action indicates on page 2 that claims 15, 16, 18, 20-23 and 25-30 are rejected under 35 U.S.C. § 102(b), the same Office Action on page 3 indicates that claims 24 and 30-32 are objected to as being dependent upon a rejected base claim, but would be allowable if written in independent form. Applicants assume that the rejection stated on page 2 and also in the Office Action Summary (where claims 15-32 are indicated as being rejected) are due to clerical error and that the indication on page 3 that claims 24 and 30-32 are allowable is correct, as it appears to be the intent of the Examiner.

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Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Therefore, all claim elements, and their limitations, must be found in the prior art reference to maintain a rejection based on 35 U.S.C. §102.

As discussed above, however, the Examiner has not given any guidance on the particular part of Moorman et al. relied on to reject these claims in the Office Action or during the telephone interview. As such, applicants do not know which part of Moorman et al. (which is a very lengthy and complex patent) is considered by the Examiner to be showing each and every element of claim 15 so as to anticipate it. Applicants do not see any disclosure in Moorman et al. of the following as recited in claim 15:

"An intravascular imaging catheter comprising:

a catheter body comprising a proximal portion and a distal portion; and

a radiation detector array disposed at the distal portion of the catheter body, wherein the radiation detector array is capable of operating both at a gross count rate and in an imaging mode." (Emphasis Added).

By not indicating the portions of Moorman et al. that show each and every element of claim 15, the Examiner failed to show that Moorman et al. anticipates claim 15. Therefore, applicants request that the rejection of claim 15 be withdrawn and that it be allowed. Since claims 16, 18, 20-23 and 25-29 depend, directly or indirectly, from

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claim 15, they incorporate all of the terms and limitations of claim 15 in addition to other limitations, which together further patentably distinguish them over the cited references. Therefore, applicants request that the rejection of claims 16, 18, 20-23 and 25-29 be withdrawn and that they be allowed.

Since the Examiner did not provide any information on the particular part of Moorman et al. relied on to reject claims 15, 16, 18, 20-23 and 25-29 as required under 37 CFR 1.104(c)(2), applicants submit that any rejection, if any, given in the next Office Action should be non-final.

IV. Rejection of Claims 17 and 19 under 35 U.S.C. § 103(a)

Claim 17 has been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Moorman et al. in view of U.S. Patent No. 5,493,595 ("Schoolman"). In order to establish a *prima facie* case of obviousness, in addition to meeting other requirements, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Schoolman is being cited for the proposition that it "discloses a stereoscopically displayed three dimensional medical imaging system that explicitly shows radiopharmaceuticals." However, the Examiner does not contend that there is any teaching or suggestion in Schoolman to overcome the deficiency of Moorman et al. to reject claim 15, and Schoolman does not have any such teaching or suggestion. For example, as discussed above, applicants do not even know which portion of Moorman et al. is considered by the Examiner to be relevant or material to claim

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15. Since the Examiner did not show how Moorman et al. anticipates claim 15, and did not show how Moorman et al. and Schoolman together would teach or suggest all limitations of claim 15, the Examiner failed to show that claim 15 is either anticipated by Moorman et al. or obvious over Moorman et al. in combination with Schoolman. Therefore, claim 15 is patentably distinguishable over Moorman et al. in view of Schoolman.

Since claim 17 depends from claim 15, it incorporates all of the terms and limitations of claim 15 in addition to other limitations, which together further patentably distinguish it over the cited references. Therefore, applicants request that the rejection of claim 17 be withdrawn and that it be allowed.

Claim 19 has been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Moorman et al. in view of U.S. Patent No. 6,801,648 ("Cheng"). Cheng is being cited for the proposition that it "discloses an optical imaging system with symmetrical optical probe that explicitly shows a 1-3 mm." However, the Examiner does not contend that there is any teaching or suggestion in Cheng to overcome the deficiency of Moorman et al. to reject claim 15, and Cheng does not have any such teaching or suggestion. Since the Examiner did not show how Moorman et al. anticipates claim 15, and did not show how Moorman et al. and Cheng together would teach or suggest all limitations of claim 15, the Examiner failed to show that claim 15 is either anticipated by Moorman et al. or obvious over Moorman et al. in combination with Cheng. Therefore, claim 15 is patentably distinguishable over Moorman et al. in view of Cheng.

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Since claim 19 depends from claim 15, it incorporates all of the terms and limitations of claim 15 in addition to other limitations, which together further patentably distinguish it over the cited references. Therefore, applicants request that the rejection of claim 19 be withdrawn and that it be allowed.

V. Allowability of Claims 24 and 30-32

Claims 24 and 30-32 have been objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Since claims 24 and 30 have been rewritten in independent form as required by the Examiner, applicants request that the objection to claims 24 and 30 be withdrawn and that they be allowed.

Since claims 31 and 32 depend from claim 30, they incorporate all of the terms and limitations of claim 30 in addition to other limitations, which together further patentably distinguish them over the cited references. Therefore, applicants request that the objection to claims 31 and 32 be withdrawn and that they be allowed.

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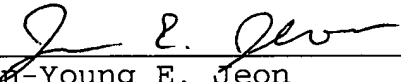
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VI. Concluding Remarks

In view of the foregoing amendments and remarks, applicants request an early issuance of a patent with claims 15-32. If there are any remaining issues that can be addressed over the telephone, the Examiner is cordially invited to call applicants' attorney at the number listed below.

Respectfully submitted,
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